

**REMARKS**

Favorable reconsideration of this application, in light of the preceding amendments and following remarks, is respectfully requested.

Claims 1-12 are pending in this application. Claims 1-12 are amended. Claim 4 is cancelled. Claims 13-28 are added. Claims 1 and 9-12 are the independent claims.

Applicant respectfully notes that the present action does not indicate that the claim to foreign priority under 35 U.S.C. §119 has been acknowledged or that certified copies of all priority documents have been received by the U.S.P.T.O. Applicant respectfully requests that the Examiner's next communication include an indication as to the claim to foreign priority under 35 U.S.C. §119 and an acknowledgement of receipt of the certified copies of all priority documents.

Applicant also respectfully notes the present action indicates that the drawings have been accepted by the Examiner. Action, summary at 10.

**Rejections under 35 U.S.C. § 101**

Claims 1-8 stand rejected under 35 U.S.C. § 101 because the Office Action stated that when nonfunctional descriptive material is recorded on some computer-readable medium, in a computer or on an electromagnetic carrier signal, it is not statutory since no requisite functionality is present to satisfy the practical application requirement. Applicant respectfully traverses this rejection.

Applicants respectfully submit that the Office Action has incorrectly characterized the medium as storing **nonfunctional** descriptive material. The Manual of Patent Examining Procedure (MPEP) provides guidance on the difference between “nonfunctional descriptive

material” and “functional descriptive material”. In particular, MPEP § 2106.01 states the following.

In this context, “function descriptive material” consists of data structures and computer programs which impart functionality when employed as a computer component. (The definition of “data structure” is “a physical or logical relationship among data elements, designed to support specific data manipulation functions.” The New IEEE Standard Dictionary of Electrical and Electronics Terms 308 (5<sup>th</sup> ed. 1993).) “Nonfunctional descriptive material” includes but is not limited music, literary works and a compilation or mere arrangement of data.

Accordingly, Applicants respectfully submit that a “computer readable medium having a data structure for managing reproduction of graphic data” as recited in independent claim 1 is a recording medium storing functional descriptive material.

MPEP §2106.01(I) further states, regarding functional descriptive material, that “a claimed computer-readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure’s functionality to be realized, and is thus statutory.” Accordingly, because the computer readable medium recited in claim 1 includes a data structure for managing reproduction of graphic data and reproducing information for reproducing one or more images and the reproducing information would allow images stored on the computer readable medium to be reproduced, claim 1 is clearly directed towards patentable, statutory subject matter.

In light of the above, Applicants respectfully request that the rejection of independent claim 1, and claims depending therefrom, under 35 U.S.C. § 101 be withdrawn.

The Applicant, therefore, respectfully requests that the rejection to Claims 1-8 under 35 U.S.C. § 101 be withdrawn.

**Rejections under 35 U.S.C. § 102**

Claims 1, 2, 4, 9, 10 and 11 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,112,011 to Hisatomi ("Hisatomi"). Applicant respectfully traverses these rejections.

A claim is anticipated only if each and every element as forth in the claim is found, either expressly or inherently described, in a single prior art reference. See MPEP Sec. 2131; *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ 2d 1051, 1053 (Fed. Cir.1987).

**Independent Claim 1**

Hisatomi does not teach or suggest all of the limitations recited by claim 1 and its dependent claims. For example, claim 1 recites a recording medium having a data structure for managing reproduction of graphic data, comprising a graphic information area including, among other things, "palette information segments, each palette information segment providing color information . . . wherein each palette information segment has an identifier; and the reproduction information identifies a palette information segment using the identifier for the palette information segment."

The office action at pages 3-4 points to Col. 18 lines 35-53 to support an argument that the Hisatomi reference does suggest at least one palette information segment, each palette information segment providing color information. Indeed, the Hisatomi reference states at Col. 18, lines 44-45: "Described in the PGC sub-picture palette (PGC\_SP\_PLT) are 16 color palettes for all sub-pictures of the PGC." Applicant respectfully believes that this statement means a palette of 16 colors (not 16 palettes) and a palette (of 16 colors) associated with each sub-picture of the PGC.

Applicant respectfully points out that claim 1 has been amended to read “pallet information segments” rather than the former language “of at least one.” It appears that the Hisatomi reference is directed to a system where in the program chain general information (PGC\_GI) 175 is a PGC sub-picture palette. There is a pallet of 16 colors for the sub-pictures for the PGC. The command (SET\_COLOR) contains the code of a color pallet (See Col. 18; lines 44-45; Col. 23; lines 18-20).

In contrast, claim 1 recites a graphic information area including palette information segments (more than one) so that the reproduction information identifies a (specific) palette information segment (among the palette information segments residing in the graphic information area). Therefore, a graphic image in accordance with claim 1 may be associated with more than one palette in the palette information. (See also paragraph [0057] of the published application).

Nowhere does Hisatomi teach or suggest a computer readable medium where a graphic image may be associated with more than one palette. Rather it contains “the code of a color pallet.” Col. 23; lines 18-20. Nor does Hisatomi teach or suggest a computer readable medium having all of the limitations included in the specific claim language recited in claim 1. Therefore, Applicant respectfully requests that independent claim 1 and its dependent claims 2-8 be allowed.

Applicant notes that independent claims 9, 10 and 11 also contain similar language to that cited with respect to claim 1. Therefore, these independent claims are allowable for at least the same reasons as described above with respect to claim 1. Therefore, Applicant respectfully requests that claims 9, 10 and 11 also be allowed.

**Rejections under 35 U.S.C. § 103**

**Hisatomi**

Claim 12 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Hisatomi as applied to claims 1, 2, 4, 9, 10 and 11 above in view of the Examiner's official notice of an encoder. Applicant respectfully traverses this rejection.

To establish a case of obviousness a clear articulation of the reasons why the claimed invention would have been obvious needs to be made. See, for example, 72 Fed. Reg. 57526, 57528 (Oct. 10, 2007). Applicant respectfully points out that independent claim 12 contains similar language as that discussed with respect to claim 1. Because the Hisatomi does not address multi-palette aspects recited above with respect to claim 1, Applicant respectfully asserts that no case of obviousness has been clearly articulated as required by the new examination guidelines for determining obviousness under 35 U.S.C. § 103 in view of the Supreme Court Decision in *KSR International Co. v. Teleflex Inc.* Therefore, Applicant respectfully requests that the rejection of claim 12 under 35 U.S.C. § 103(a) be removed.

**Hisatomi + Parks**

Claims 3 and 8 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hisatomi as applied to claims 1, 2, 4, 9, 10 and 11 above, and further in view of U.S. Patent No. 6,850,228 B1 to Parks et al. ("Parks"). Applicant respectfully traverses these rejections.

Claims 3 and 8 ultimately depend from claim 1, which has been shown to be allowable over the Hisatomi reference at least for the reasons cited above. Therefore, claims 3 and 8 are allowable at least by reason of their dependency as well as for their own merits.

The Applicant, therefore, respectfully requests that the rejection to Claims 3 and 8 under 35 U.S.C. § 103(a) be withdrawn.

**Hisatomi + Fujimoto**

Claims 5 and 6 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hisatomi as applied to claims 1, 2, 4, 9, 10 and 11 above, and further in view of U.S. Patent No. 5,912,710 to Fujimoto (“Fujimoto”). Applicant respectfully traverses these rejections.

Claims 5 and 6 are ultimately dependent on independent claim 1 which has been shown to be patentable for the reasons stated above. Thus, claims 5 and 6 are patentable at least by reason of their dependency on claim 1, as well as for their own merits.

The Applicant, therefore, respectfully requests that the rejection to Claims 5 and 6 under 35 U.S.C. § 103(a) be withdrawn.

**Hisatomi**

Claim 7 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Hisatomi as applied to claims 1, 2, 4, 9, 10 and 11 above. Applicant respectfully traverses this rejection.

Claim 7 depends on independent claim 1, which has been shown to be patentable for the reasons stated above. Claim 7 is patentable by reason of its dependency as well as for its own merits.

The Applicant, therefore, respectfully requests that the rejection to Claim 7 under 35 U.S.C. § 103(a) be withdrawn.

**CONCLUSION**

In view of the above remarks and amendments, the Applicants respectfully submit that each of the pending objections and rejections has been addressed and overcome, placing the present application in condition for allowance. A notice to that effect is respectfully requested. If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to contact the undersigned.


Pursuant to 37 C.F.R. §§ 1.17 and 1.136(a), Applicant(s) hereby petition(s) for a three (3) month extension of time for filing a reply to the outstanding Office Action and submit the required extension fee herewith.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Mr. Alan Larson, Reg. No. 53,184, at the telephone number of the undersigned below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 08-0750 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

HARNESS, DICKY, & PIERCE, P.L.C.

By  55,149  
For Gary D. Yacura, Reg. No. 35,416

P.O. Box 8910  
Reston, Virginia 20195  
(703) 668-8000